

Remarks

Rejection Pursuant to 35 U.S.C. § 103(a) Over Newman et al. (US 6,054,205) in view of Mathieu (US 6,187,409) Galer (US 4,450,022) Canada (CA 2006149) and Berke et al. (US 5,753,368) and the citation of *KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL.*

The Advisory Action cites *KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL* for the principle that any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.

The rejection based on KSR is respectfully traversed for non-compliance with the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, as set out in to the **Federal Register**/Vol. 72, No. 195/ Wednesday, October 10, 2007/ Notices.

Reference is made to the **Federal Register**/Vol. 72, No. 195/ Wednesday, October 10, 2007/ Notices, setting forth, Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 In View Of the Supreme Court Decision in *KSR International Col v Teleflex Inc.*

To reject a claim based on one of the following Rationales, Office personnel must resolve the *Graham* factual inquiries. The Rationales:

- (A.) Combining prior art elements according to known methods to yield predictable results.
- (B.) Simple substitution of one known element for another to obtain predictable results.
- (C.) Use of known technique to improve similar devices (methods, or products) in the same way.
- (D.) Applying a known technique to a known device (method, or product)ready for improvement to yield predictable results.
- (E.) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.

- (F.) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.
- (G.) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art teachings to arrive at the claimed invention.

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1.) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

The reliance on KSR in the rejection does not resolve the *Graham* factual inquiries, and does not conform to any of the Rationales (A.) through (G.) above. Accordingly, the rejection is respectfully traversed.

Respectfully submitted,

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